

ATTORNEY DOCKET NO. DIY

Serial No.: 09/682,853

RECEIVED
CENTRAL FAX CENTER

Doc Code: AP.PRE.REQ

OCT 04 2005

ATTORNEY DOCKET NO. DIY

Serial No.: 09/682,853

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Scott C. Harris

Art Unit : 2152

Serial No.: 09/682,853

Examiner : Barqadle

Filed : October 24, 2001

Title : WEB BASED COMMUNICATION OF INFORMATION WITH
RECONFIGURABLE FORMAT

Assistant Commissioner for Patents
Washington, D.C. 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection in the above-identified application.
No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s). Note:
No more than five (5) pages may be provided.

*Total of 1 forms are submitted.

CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this correspondence and all marked
attachments are being facsimile transmitted to the Patent and
Trademark Office on the date shown below:

10/8/05
Date of Deposit

Signature

Scott Harris
Typed or Printed Name of Person

-1-

Pre-appeal Brief Request for Review

09/682,853

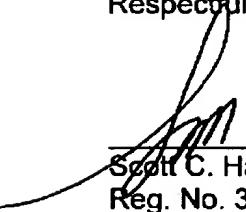
Page 1

RECEIVED
OICE/AP
OCT 05 2005

ATTORNEY DOCKET NO. DIY
Serial No.: 09/682,853

Respectfully submitted,

Date: 10/4/05



Scott C. Harris
Reg. No. 32,030

Customer No. 23844
Scott C. Harris, Esq.
P.O. Box 927649
San Diego, CA 92192
Telephone: (619) 823-7778
Facsimile: (858) 678-5082

Pre-appeal Brief Request for Review
09/682,853
Page 2

ATTORNEY DOCKET NO. DIY
Serial No.: 09/682,853

To summarize this request:

1) Chen teaches away from requesting additional information, and therefore it would not be obvious to combine Chen with a reference which requests additional information, and 2) even if the combination were made, the hypothetical combination still would not teach what is now claimed. This is explained in further detail below.

I. Chen Teaches Away From Requesting Additional Information, And Therefore One Having Ordinary Skill In The Art Would Not Combine Chen With Any Kind of Reference Which Teaches Requesting Additional Information.

Claim 1 specifies sending a request for information, and then sending back a request that requests the interactive device to identify more information about the specific query to be made. However, it is respectfully suggested that Chen teaches away from requesting identification of more information in this way, and therefore that it would not be obvious to combine Chen with any reference that suggests obtaining additional information.

It is well established in the case law and in MPEP 2143.01, that prior art can only be combined when the prior art itself suggests the desirability of the claimed combination. Here, in fact, the prior art teaches AWAY from the desirability of such a combination.

Chen teaches using a mobile device to issue requests, one of which is for example the latest stock price. See for example Chen at paragraph 11. As part of the request, the engine "transforms command aliases" of the received request. That is, the engine tries to make sense of the command as is, rather than requesting further information about the command. This is entirely consistent with all of the teaching throughout Chen.

The rejection states that nothing in Chen precludes obtaining additional information about the command. However, that is not the proper test for whether a combination is proper -- The proper test is whether an ordinarily skill artisan would be motivated to combine the references. When combining contradicts either of their teachings, this certainly mitigates against such motivation. Here, Chen teaches that

Pre-appeal Brief Request for Review
09/682,853
Page 1

ATTORNEY DOCKET NO. DIY
Serial No.: 09/682,853

one should use the received command as it is, rather than asking for more information. For example, consider the command syntax disclosed in paragraph 55 of Chen. Paragraph 57 describes that the engine components form aliases, and authenticates the user. Again here, the engine components attempts to recognize the command as is; the antithesis of asking for additional information about the command. In all of Chen's embodiments, when the system needs more information than it has, it finds the additional information from the user profile, not by asking for additional information. See for example paragraph 76 which explains that when Chen requires additional information, it obtains it from the profile. In paragraph 101, when the system needs to know who to send the information to, it gets it from the profile. All in all, it should be seen that Chen teaches that when not enough information is obtained about the request that is received, then the additional information should be figured out based on internal logic and the user profile.

Any attempt to modify Chen to operate in a different way would go against the teaching in Chen about how to interpret incomplete requests. Accordingly, one having ordinary skill in the art would not modify Chen to request additional information. In fact, doing so would go against the teaching in Chen, making this an improper combination under MPEP 2143.

Therefore, one having ordinary skill in the art would not combine Chen with Steele or with any other reference that showed obtaining additional information.

II. Even If The Hypothetical Combination Of Chen In View Of Steele Were Made, It Would Still Not Teach Or Suggest The Claimed Subject Matter.

Steele teaches a multimedia system which, as part of the system, includes advertisements. The user can request, and receive, additional information about the product being advertised. For example, the user can request information using an INFO button such as 172 (paragraph 56) which causes the advertising database to provide information about the advertisement that is being run (see paragraph 63). The user can also request buying information.

Pre-appeal Brief Request for Review
09/682,853
Page 2

ATTORNEY DOCKET NO. DIY
Serial No.: 09/682,853

However, Steele in combination with Chen is very different than what is currently claimed. Claim 1 defines a request for information being sent from an interactive device to a first recipient, and that the first recipient requests the interactive device to identify more information about the query. In Steele, a user receives advertisements, and can request more information about the advertisement. However, Steele's advertisement is not a "query" as claimed. Moreover, Steele's advertisement is not a request for information sent from an interactive device to a first recipient. Rather, Steele's advertisement is sent over an Internet channel to all users. The recipient can send a request for more information about the advertised product, but the recipient does not send a request for "said interactive device to identify more information about a specific query to be made to said publicly accessible source of information", emphasis added. Quite simply, while Steele requests information, it is not "information about a specific query to be made", but is rather information about an advertisement. An advertisement is not a specific query to be made to a publicly accessible source of information. A query to a source of information requests that the source of information return some answer. In contrast, an advertisement sent to a number of users is in no sense a 'query', it does not request an answer to any specific question.

Therefore, Steele does not suggest requesting "more information about a specific query" sent from an interactive device with the purpose of querying a publicly available source of information. Steele ONLY teaches requesting more information about an advertisement.

Therefore, a hypothetical combination of Chen with Steele would produce a Chen type system with a Steele type system that may allow requesting additional information about advertised items. Therefore, claim 1 should be allowable along with claims 2-8 which depend therefrom. Each of these claims should be allowable on their own merits.

Claim 17 specifies receiving a request for information from a publicly available source of information, and sending a request to the client for more detail about that request. As described above, the hypothetical combination of Chen in view of Steele (1) would not be operatively made by one having ordinary skill in the art, and (2) even if made would simply teach a Chen type system with Steele system of requesting

Pre-appeal Brief Request for Review
09/682,853
Page 3

ATTORNEY DOCKET NO. DIY
Serial No.: 09/682,853

additional information about an advertisement. Nothing in the hypothetical combination teaches or suggests how an interactive device could query a publicly available source of information by obtaining more information about the query itself. Therefore, claim 17 should be allowable along with the claims which depend therefrom.

Claim 21 specifies sending a text message from an e-mail pager to a specified address and includes text content including an action that the user wants to carry out, second sending a text message back, and after sending that, carrying out an operation. As described above, Chen in view of Steele would not teach or suggest this feature, since it would just teach a Chen type system with a Steele advertisement request. Therefore, claim 21 is not obvious, and should be allowable along with the claims which depend therefrom.

Claim 23 should be specifically allowable as it specifies that the second sending is a request for confirmation of contents. This may be useful in a situation where the command may be ambiguous, and in that case, the second sending may be a request for confirmation. The rejection attempts to read this as being a "request for information of contents of said action" as disclosed in Steele paragraph 131. However, this cited section simply teaches sending information to the vendor that indicates there is a user that meets certain requirements; allowing the vendor to request additional detail. It is certainly not a request for confirmation of contents of an action, as claimed. In fact, Steele teaches absolutely NOTHING about any messages CONFIRMING any actions, not even in the specific advertising context. Therefore, Claim 23 should be allowable.

Claim 8-10 was rejected over Chen in view of Rajan. Claim 8 defines that the source of information indicates a user's bank balance, which is even further patentably distinct from the references. Claim 8 also includes the limitations of claim 5 in which the sending requires that the user provide some personal information to verify their identity. Chen in view of Rajan teaches nothing about this.

Claim 9 specifies that the reformatting is done according to a prestored template. Rajan does teach that information can be reformatted between templates, but teaches nothing about the subject matter of claim 9 which specifies reformatting for an

Pre-appeal Brief Request for Review
09/682,853
Page 4

ATTORNEY DOCKET NO. DIY
Serial No.: 09/682,853

interactive device according to a prestored template. Therefore, claim 9 should be allowable along with claim 10 which depends therefrom.

Finally, and with all due respect, the patent office is respectfully suggested to be using an improper test for determining whether references can be combined. Statements in the office action that "nothing precludes...", "can readily support...", "is flexible and would be perfectly OK to combine with..." do not define the proper test for combination. As the rejection recognizes, the proper test is whether an ordinarily skilled person would be motivated to make the combination. When a reference teaches away from something, one having ordinary skill in the art would not be presumed to look for another reference to show that feature. Why would one? In fact, doing so would contradict the reference's teaching. If the only reason is simply because "it is perfectly OK to do", this rejection is based on hindsight, not suggestion. Obviousness must be based on the teaching of the references. The statement that it is perfectly OK demonstrates that the rejection was based on hindsight, not on the teaching of the references.

Therefore, and with all due respect, the rejection should be reversed.
Respectfully submitted,

Date: 10/4/05



Scott C. Harris
Reg. No. 32,030

Customer No. 23844

Pre-appeal Brief Request for Review
09/682,853
Page 5